

Appl. No. : 10/789,630
 Filed : February 27, 2004

REMARKS

Applicant respectfully requests consideration of the above-identified application in view of the amendments set forth above and the comments set forth below. By way of summary, at the time of the Office Action, Claims 1-7, 15-17 and 24-33 were pending in this application. None of the claims have been amended or cancelled in this Response.

Rejection under 35 U.S.C. § 132 and Rejection under 35 U.S.C. § 112, First Paragraph

Claim 24 was rejected under 35 U.S.C. § 132 and Claims 24-30 were rejected under 35 U.S.C. § 112, first paragraph. The Examiner has taken the position that Figure 6 "clearly shows a relief cut in the narrow portion 102 disposed between the extension 108 and the handle 104." Applicant respectfully disagrees.

As an initial matter, the rejection under 35 U.S.C. § 132 is improper. Rejections under 35 U.S.C. § 132 generally are reserved for amendments to the specification, the abstract and the drawings. Claims are to be rejected under 35 U.S.C. § 112, first paragraph. *See MPEP§ 2163.01.* Withdrawal of the rejection under 35 U.S.C. § 132 of Claim 24 is respectfully requested.

With respect to the rejection under 35 U.S.C. § 112, first paragraph, Applicant has struggled to understand which portion of the handle the Examiner contends is a "relief cut."

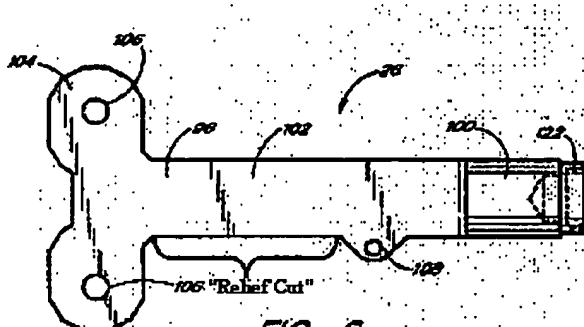


FIG. 6

Accordingly, to confirm what Applicant has assumed to be the Examiner's position, Applicant has included a copy of Figure 6 to the left with an indicator of the section presumed to contain the "relief cut" as argued by the Examiner.

In paragraph [0053] of the specification, Applicant states: "The narrow arm portion 102 preferably has a width that allows the arm to bend when the locking cap 20 is sufficiently tightened into position to reduce the likelihood of over-tightening the locking mechanism 36. For instance, when the key 26 is over-torqued, the narrow arm portion 102 may begin to assume a permanently set spiral bend configuration. By deforming in such a manner, the key 26 provides a mechanism for protecting the locking cap and pipe as well as indicates to the user that the bolt is being over-torqued." The bending does not take place at a section having

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a reduced dimension formed at a relief cut. Rather, the illustrated key, in both directions from the flange 108, has a generally uniform dimensional configuration and deforms along the length of the narrow arm portion 102.

To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. In this case, the figures together with the content of paragraph [0053] show and describe, implicitly at the very least, a key without a relief cut. The key has a very small flange 108 that forms a place at which a ring can be attached to the key. The body of the illustrated key, however, has a generally consistent width both before and after the flange 108. Thus, Applicant does not understand how the region of the key between the flange and the cross-member portion 104 can be considered a "relief cut" as that term is used in the prior art and by those of ordinary skill in the art.

Patterson et al., for instance, shows a torque wrench with an undercut or relieved portion. The relief cut shown by Patterson et al. is a section of reduced cross-section relative to the balance of the key. This is how the term would be understood by those of ordinary skill in the art and Patterson et al. is but one piece of evidence in support of this understanding.

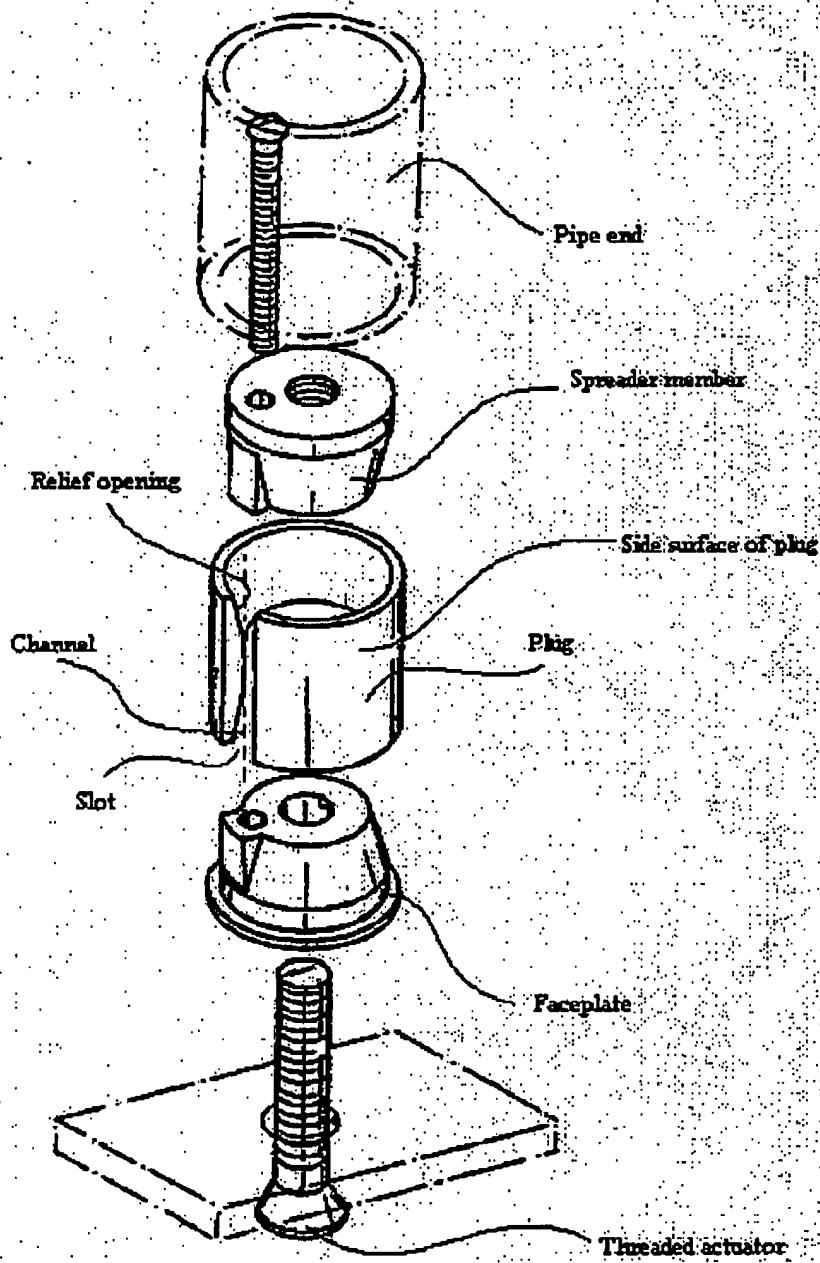
Thus, based upon the drawings, the specification and the meaning of "relief cut" as understood by those of ordinary skill in the art, the application clearly conveys that the Applicant had invented a key without a relief cut at least as early as the filing of the application.

Claims 1-3, 32 and 33 Are Patentable Over Hoshino

Claims 1-3, 32 and 33 stand rejected as anticipated by Hoshino (U.S. Patent No. 5,419,650). Applicant respectfully submits that Claims 1-3, 32 and 33 are not anticipated by this reference for at least the reasons explained in greater detail below.

Applicant and the Examiner appear to be misunderstanding one another. As such, Applicant has included a modification of Figure 1 of Hoshino to set forth how Applicant believes that the Examiner is applying Hoshino. With this understanding of Hoshino, Applicant will address some of the limitations believed to be missing from Hoshino

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As shown to the left, the Examiner has construed the lumen through the "plug" as comprising both "the relief opening" and the "channel". The "channel" has been defined at the narrowest portion of the lumen with the "relief opening" being defined as the sloping wall of the plug.

Each of Claims 1, 32 and 33 recites, among other limitations, a channel that receives a longitudinally translatable spreader member wherein at least one surface of the spreader member or the channel is tapered such that the spreader member and the channel cooperate to expand and contract the plug portion. Under the

Examiner's construction, the channel is "coextensive with the surface 23 in Fig. 1), which has been indicated by the dashed line in the modified figure above. The channel is cylindrical and its only actual surface, surface 23, is positioned at a location within the "plug" that will not contact any tapered surface of the "spreader member," as shown in Figure 2 of Hoshino. Thus, the channel and the spreader member cannot cooperate to expand and contract the plug portion.

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Rather, under the Examiner's construction, the spreader member and the tapering surface of the "relief opening" cooperate to expand and contract the plug portion. Thus, Hoshino does not anticipate Claim 1, 32 or 33 as currently pending.

Moreover, Claim 33 recites, among other limitations, the plug portion of the fire department connection locking cap sized and configured to be received by the pipe end of the fire department connection with the side surface of the plug portion having a surface area generally coextensive with an inner contacted surface of the pipe end of the fire department connection. Applicant respectfully submits that Hoshino did not disclose any structure associated with a fire department locking cap or a fire department connection. All limitations of a claim must be given patentable weight and, in order to anticipate a claim, a single reference must disclose all limitations of that claim. For at least these reasons as well as those discussed above, Hoshino does not anticipate Claim 33.

Reconsideration of Claims 1-3, 32 and 33 is respectfully requested.

Claim 7 Is Patentable Over the Combination of Hoshino and Borenstein

Claim 7 stands rejected as unpatentable over the combination of Hoshino and Borenstein (U.S. Patent No. 4,651,771). The Office Action states that "Hoshino teaches a plug member on a locking cap but fails to specify the material used." Borenstein is then combined with Hoshino to assert that the material from Borenstein, brass, can be combined with Hoshino, and in doing so, the combination allegedly renders Claim 7 obvious. Applicant respectfully submits that Claim 7 is patentable over this combination for at least the reasons explained below.

Claim 7 is patentable over the combination for at least two reasons. First, Claim 7 depends from Claim 1, and as explained previously, Hoshino does not teach all the limitations recited in Claim 1. As Borenstein is only combined with Hoshino to establish a choice of material, the combination of Hoshino and Borenstein still lack a teaching or suggestion of all the limitations of Claim 1. Accordingly, Claim 7 should be allowed because it depends from an allowable claim.

Second, if Hoshino and Borenstein are combined, the combination would be for the purpose of establishing a brass plug portion. The plug portion of Hoshino, however, is a thin-walled tube, and combining the references would necessarily result in a brass, thin-walled tube. The brass, thin-wall tube would necessarily yield too easily and would not return to a compressed

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state when the moveable member is retracted. Thus, the combination would render Hoshino unfit for its intended purposes. Applicant, therefore, respectfully submits that the combination of Hoshino and Borenstein is inappropriate as it would render the modified reference unfit for its intended purpose.

Reconsideration and allowance of Claim 7 is respectfully requested.

Claims 4–6 Are Patentable Over the Combination of Hoshino and Segal

Claims 4–6 stand rejected as unpatentable over the combination of Hoshino in view of Segal (U.S. Patent No. 5,803,110). Claims 4–6 depend from Claim 1, and as explained previously, Hoshino does not teach all the limitations recited in Claim 1. As Segal is only combined with Hoshino to establish an allegedly similar key head, the combination of Hoshino and Segal still lack a teaching or suggestion of all the limitations of Claim 1.

Moreover, Claim 5 recites that the female pattern is a cloverleaf consisting of seven apexes and eight wavy grooves interconnecting the seven apexes. As such, the pattern of Claim 5 must have seven apexes and no more. Thus, Claim 5 is not taught by the combination. Accordingly, Applicant respectfully submits that Claims 4–6 should be allowed because they depend from an allowable claim and that at least Claim 5 also recites further patentable distinctions. Thus, reconsideration and allowance of Claims 4–6 is respectfully requested.

Amended Claims 15–17 Are Patentable Over the Combination of Hoshino and Drach

Claims 15–17 stand rejected as unpatentable over the combination of Hoshino in view of Drach (U.S. Patent No. 4,526,193). Claims 15–17 have been amended, and the Applicant respectfully submits that the amended claims are patentable over the combination.

Drach teaches pins that are used to drive an inner member, which operates the valve, or tightens and loosens the plug over the opening. Consequently, the outer body is permitted to rotate relative to the pins. In contrast, amended Claim 15 recites that the pins are “connected to the plug to allow rotation of the plug but not to facilitate expansion or contraction of the plug.” Consequently, the pins are coupled to the body of the plug and not to the moveable member or actuator. Such an arrangement is not taught or suggested by the combination of Hoshino and Drach, and Applicant respectfully submits that Claim 15 is in condition for allowance over the combination.

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Additionally, as Claims 16 and 17 depend from Claim 15, which is in condition for allowance, Applicant respectfully submits that Claims 16 and 17 are also in condition for allowance. Thus, reconsideration and allowance of Claims 15-17 is respectfully requested.

Claims 24-30 Are Patentable Over The Various Applied Combinations

Claims 24-30 stand rejected as unpatentable over Patterson (U.S. Patent No. 5,295,831), the combination of Patterson and Stehling (U.S. Patent No. 5,033,501), and the combination of Patterson and Borenstein. Applicant respectfully submits that the amended claims are patentable over the combination.

Applicant reiterates that Patterson is the primary reference used in rejecting the Claims 24-30 and discloses a disposable torque wrench for dental components. The torque wrench of Patterson requires a relief cut to ensure that the wrench will yield as described by the patent. Claim 24 has been amended to recite that the locking cap keys do not include a relief cut, as required by Patterson. Accordingly, Applicant respectfully submits that the amendment distinguishes Patterson and places Claim 24 in condition for allowance. None of the other applied references teach a deforming zone without a relief cut.

Additionally, as Claims 25-30 depend from Claim 24, which is in condition for allowance, Applicant respectfully submits that Claims 25-30 are also in condition for allowance. Thus, reconsideration and allowance of Claims 24-30 is respectfully requested.

New Claims 34-38 Have Been Added

Claims 34-38 have been added to vary the scope of protection afforded by the present claims. These claims depend from Claim 1, which is presently believed patentable. Moreover, these claims are believed to distinguish over the applied references. Furthermore, these claims are supported by, for example, Figures 3A and 3B. Consideration and allowance of these claims are respectfully requested.

CONCLUSION

For the foregoing reasons, it is respectfully submitted that the rejections set forth in the outstanding Office Action are inapplicable to the present claims. Accordingly, issuance of a Notice of Allowance is most earnestly solicited. In the event that this Response does not place

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the present application in condition for allowance, Applicant would like to discuss this application with the Examiner to secure allowance without the need for an appeal. For this reason, Applicant requests that the Examiner contact the undersigned at (949) 721-6359 prior to issuing any further rejections of the present application.

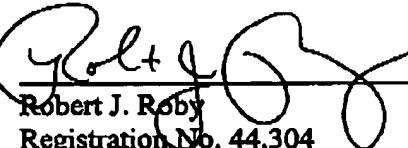
The undersigned has made a good faith effort to respond to all of the rejections in the case and to place the claims in condition for immediate allowance. Nevertheless, if any undeveloped issues remain or if any issues require clarification, the Examiner is respectfully requested to call Applicant's attorney in order to resolve such issues promptly.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 4.7.2005

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